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ON PETITION

In re Application of
GREEN
Application No. 08/709,930
Filed: September 9, 1996
Attorney Docket No. 000287-00482

This is a decision on the petition filed December 2, 2002, which requests under 37 CFR 1.182 that the record be clarified regarding the real party in interest.

The petition is granted.

Petitioner asserts that, while SRI International (SRI) is, by an assignment of the parent case recorded in the records of the USPTO, the assignee of the entire right title and interest in the above-identified application, several papers in the associated *inter partes* interference, No. 104,643, have identified the Green real party in interest as Intuitive Surgical. Petitioner seeks clarification as to its status as "the real party in interest" and that Intuitive Surgical, Inc., as the exclusive licensee may be "a real party in interest." Petitioner is correct.

Initially, the papers referred to in the petition are located in the file wrapper for the above-noted interference and, as such, are not part of this file, except for their introduction as exhibits to the petition. Petitioner may wish to seek clarification of this same issue in the above-noted Interference file, which is within the jurisdiction of the Board of Patent Appeals and interferences (BPAI).

The term "real party in interest" was added to the rules pertaining to both *ex parte* appeals and *inter partes* interferences in the "Miscellaneous Changes in Patent Practice" rulemaking, effective April 21, 1995 and published at 60 *Fed. Reg.* 14488 (Mar. 17, 1995). The purpose of this particular change was to (1) permit members of the BPAI to comply with applicable ethics regulations in which any member might have an interest in any party so identified, and (2) ensure consistency in decisions in related cases. See 60 F.R. 14499. Manifestly that very limited change did not extend

to the rules pertaining to ownership of an application, nor as to those pertaining to who may control the prosecution of an application.

An assignment of the entire right, title, and interest, passes both legal and equitable title. See, Wende v. Horine, 191 F. 620, 621 (C.C.N.D. Ill. 1911). The recorded assignment of the parent application carries to the continuing application. See MPEP 306. SRI, as the assignee of the entire interest, is free to deal with this application as SRI wills. See Garfield v. Western Electric Co., 298 F. 659 (S.D.N.Y. 1924). Only the owner of the *entire* interest in an application has the sole right to control prosecution of an application. See In re Goldstein, 16 USPQ2d 1963, 1964 (Comm'r Pat. 1988; see also In re Scold, 195 USPQ 335, 335 (Comm'r Pat. 1976); Ex parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924). The scope of the assignee's powers is further amplified in MPEP 324.

The procedures set forth in the regulations (e.g., 37 CFR §§ 1.36, 3.71 and 3.73(b)) serve to assure that papers filed with the PTO in an application or patent are submitted on behalf of the owner(s) of the *entire* interest in the application or patent. See Goldstein, 16 USPQ2d at 1964. Thus, SRI, and only SRI, as the assignee of the entire interest may do with this application as SRI pleases. While Intuitive Surgical, Inc., may be the exclusive licensee, the rules of practice simply do not recognize an exclusive licensee or permit an exclusive licensee to have any control whatsoever in the prosecution of this or any other application. The entire ownership interest, and the entire and sole right to control the prosecution of this application resides in SRI.

Any confusion that the USPTO may have caused SRI is sincerely regretted.

This application is being forwarded to Technology Center AU 2125.

Telephone inquiries relative to this decision should be directed to the undersigned at (703) 305-1820.



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